

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	Before the Examiner:
Vincent C. Conzola	:	Daniel A. Hess
Serial No.: 10/776,112	:	Group Art Unit: 2876
Filed: February 11, 2004	:	
Title: PRODUCT CHECKOUT	:	IBM Corporation
SYSTEM WITH ANTI-THEFT	:	P.O. Box 12195
DEVICE	:	Dept. T81/503
	:	Research Triangle Park, NC 27709

REPLY BRIEF UNDER 37 C.F.R. §41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is being submitted in response to the Examiner's Answer dated April 18, 2006, with a two-month statutory period for response set to expire on June 18, 2006.

I. RESPONSE TO EXAMINER'S ARGUMENTS

- A. Response to Examiner's argument that Appellant is attacking references individually in connection with claims 9 and 24, as discussed on pages 9 and 10 of Examiner's Answer.

The Examiner had previously cited column 1, line 10 and the Abstract of Novak as teaching the limitation of "a check-out method for a product having a security tag associated therewith" as recited in claim 9 and similarly in claim 24. Office Action (11/29/2005), page 3. As a result, Appellant traversed this rejection by asserting that Novak does not teach a check-out method for a product having a security tag associated therewith. The Examiner now admits that Novak is missing the claim limitation of "a security tag associated therewith." Examiner's Answer, page 9. The Examiner though asserts that the Appellant is attacking the references individually since Appellant argued that Novak does not teach a check-out method for a product having a security tag associated therewith. Examiner's Answer, page 9. However, Appellant, in Appellant's Second Appeal Brief, was only responding to the Examiner's assertion that column 1, line 10 and the Abstract of Novak teach the limitation of "a check-out method for a product having a security tag associated therewith." Appellant was not attempting to attack the references individually as asserted by the Examiner.

Furthermore, the Examiner states that Novak teaches all of the limitations but "deactivation." Examiner's Answer, page 9. However, the above-cited claim limitation does not recite "deactivation." It states "having a security tag associated therewith." The Examiner is required to provide a reference or combination of reference that teaches or suggests all of the claim limitations. M.P.E.P. §2143. The Examiner has not specifically cited any passage in either Novak or Bellis where "having a security tag associated therewith" is taught. Further, it makes no sense to separate the clause "a check-out method for a product" with the clause "having a security tag associated therewith." It would seem that the Examiner would have to provide a reference that teaches the entire complete thought of a "product having a security tag associated therewith." The Examiner though ignores that requirement by

asserting that Appellant is attacking references individually. This is improper. Appellant is not engaged in some piecemeal analysis as asserted by the Examiner. See Examiner's Answer, page 10. As stated above, the Examiner must provide a reference or combination of references that teaches or suggests all of the claim limitations. M.P.E.P. §2143. By the Examiner not fulfilling this requirement, the Examiner has not established a *prima facie* case of obviousness in rejecting claims 9 and 24. M.P.E.P. §2143.

Further, if the Examiner is now asserting that Novak is missing the claim limitation of "having a security tag associated therewith," as recited in claims 9 and 24, in connection with a product, then the Examiner must provide a motivation or suggestion for modifying Novak to include such a limitation in order to establish a *prima facie* case of obviousness. M.P.E.P. §2143. The Examiner has not provided a motivation for modifying Novak's product to have a security tag associated therewith. Consequently, the Examiner has not provided a *prima facie* case of obviousness in rejecting claims 9 and 24. *Id.*

Further, the Examiner states:

If the Appellant is attempting to assert that Novak is nonanalogous art, the Examiner strongly disagrees and notes that Novak is very much within the Appellant's field of endeavor, even if the field of endeavor is defined very narrowly. Examiner's Answer, page 10.

There is no basis for the Examiner to believe that Appellant is arguing that Novak is nonanalogous art based on the arguments presented on pages 4-5 of Appellant's Second Appeal Brief. By the Examiner making such an assertion, the Examiner is only confusing the issues for the Board to review.

- B. Response to Examiner's assertion that Novak and Bellis, taken in combination, teach or suggest "deactivating said tag with a deactivation device after receipt of said signal and while said product is in said substantially enclosed area," as discussed on pages 12-13 of Examiner's Answer.

The Examiner appears to admit that Bellis does not teach the entire limitation of "deactivating said tag with a deactivation device after receipt of said signal and while said product is in said substantially enclosed area" as recited in claims 9 and 24. Examiner's Answer, page 12¹. The Examiner had previously cited paragraph [0040] of Bellis as teaching the above-cited claim limitation. Office Action (11/29/2005), page 5. The Examiner is now asserting that it would have been obvious to modify Novak to deactivate the tag while the product is in the substantially enclosed area (1) because of the way Novak is physically arranged and (2) because it provides an ideal opportunity in Novak for deactivation. Examiner's Answer, page 12. The Examiner though has not provided a reference that teaches or suggests deactivating a tag while the product is in the substantially enclosed area. The Examiner must first identify a prior art reference (or references when combined) that teach or suggest all of the claim limitations. M.P.E.P. §2143. The Examiner though appears to imply that it is self evident to deactivate a tag while the product is in the substantially enclosed area. However, the Examiner is still required to first present a reference that teaches deactivating a tag while the product is in the substantially enclosed area. *Id.* If that limitation is not found within the primary reference, then the Examiner must provide a motivation or suggest for modifying the primary reference to include the missing claim limitation(s). *Id.* The Examiner though admits that both Novak and Bellis do not teach deactivating a tag while the product is in the substantially enclosed area. See Examiner's Answer, pages 12-13. Since the Examiner has not first provided a reference that teaches deactivating a tag while the product is in the substantially enclosed area, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 9 and 24. M.P.E.P. §2143.

Further, the Examiner's two reasons as to why it would be obvious to modify Novak to include the aspect of deactivating a tag while the product is in the substantially enclosed area appears to be focusing on the fact that it would be possible to modify Novak to include the aspect of deactivating a tag while the product is in the

¹ The language underlined is the language the Examiner admits that Bellis does not teach.

substantially enclosed area. The mere fact that Novak can be modified to include the aspect of deactivating a tag while the product is in the substantially enclosed area does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). The Examiner cites Figure 1; column 3, lines 17-19; and column 7, lines 55+ of Novak in connection with the two reasons as to why it would be obvious to modify Novak to include the above-cited claim limitation. Examiner's Answer, page 12. However, there is no language in the cited passages that suggest the desirability of deactivating a tag while the product is in the substantially enclosed area. As a result, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 9 and 24. M.P.E.P. §2143.01.

Further, the Examiner implies that the goal of Appellant's invention is to isolate products within a tunnel. Examiner's Answer, page 13. That is not the goal of Appellant's invention. There is no language limiting Appellant's invention to isolating products within a tunnel. Neither, and more importantly, is there any language in the claims limiting Appellant's invention to isolating products within a tunnel.

- C. Response to Examiner's contention that Novak and Bellis teach "a scanner for retrieving from said database said one or more physical characteristics" as recited in claim 24, as discussed on pages 13-14 of Examiner's Answer.

Appellant asserted in Appellant's Second Appeal Brief that the Examiner had not cited to any passage in either Novak or Bellis as teaching "a scanner for retrieving from said database said one or more physical characteristics" as recited in claim 24. Appellant's Second Appeal Brief, page 8. The Examiner responds by citing references from Novak using a database in making comparisons of physical characteristics. Examiner's Answer, pages 13-14. However, the Examiner is ignoring claim language. All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); M.P.E.P. §2143.03. The limitation in claim 24 states "a

scanner for retrieving from said database said one or more physical characteristics." The Examiner still has not provided a reference (despite all of the citations on pages 13-14 of Examiner's Answer) in either Novak or Bellis that teaches "a scanner for retrieving from said database said one or more physical characteristics." As a result, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 24, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

- D. Response to Examiner's contention that Novak and Bellis teach "ensuring no other object is in said substantially enclosed area once said product has been placed in said substantially enclosed area but before said tag has been deactivated" as recited in claim 15 and similarly in claim 30, as discussed on page 16 of Examiner's Answer.

The Examiner cites column 7, lines 55-60 of Novak as teaching the limitation of ensuring no other object is in the substantially enclosed area once the product has been placed in the substantially enclosed area but before the tag has been deactivated, as recited in claim 15 and similarly in claim 30. Examiner's Answer, page 16. Appellant respectfully traverses.

Novak instead teaches that if for some reason the system cannot identify a specific item, (for example, because someone accidentally placed two items on the conveyor or if a timer (not shown) is used to indicate that a predetermined amount of time has elapsed for the object identification to take place), the conveyor is started and moves the object(s) to the bagging area. Column 7, lines 57-62. Novak further teaches that in this case, the digital image can be converted to video and the direct video signal depicting the object is forwarded to the central station along with data, such as the product name, UPC number and video image for the subset of objects from which the object belongs. Column 7, lines 62-67.

There is no language in the cited passage that teaches ensuring no other object is in the substantially enclosed area once the product has been placed in the substantially enclosed area. Neither is there any language in the cited passage that teaches ensuring no other object is in the substantially enclosed area once the product

has been placed in the substantially enclosed area but before the tag has been deactivated. Novak's teaching of converting the digital image to video as well as forwarding the direct video signal depicting the object to the central station along with data, does not imply alerting a cashier to prevent multiple objects from being placed in the substantially enclosed area as suggested by the Examiner. See Examiner's Answer, page 16. There are already multiple items on the conveyor prior to converting the digital image to video as well as forwarding the direct video signal. Further, assuming *arguendo* that Novak teaches alerting a cashier once multiple objects are detected as being placed in the substantially enclosed area as suggested by the Examiner, this does not imply the teaching of ensuing no other object is in the substantially enclosed area once the product has been placed in the substantially enclosed area but before the tag has been deactivated. See Examiner's Answer, page 16. Thus, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 15 and 30, since the Examiner is relying upon incorrect, factual predicates in support of the rejections. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Further, the Examiner makes a statement implying that Appellant's invention triggers a response after a second object has been inserted and that this is the means for ensuring no other object is in the substantially enclosed area. Examiner's Answer, page 16. Appellant respectfully traverses such an interpretation. There is no language in the Specification that supports such a statement made by the Examiner.

- E. Response to Examiner's assertion that the Examiner has provided appropriate motivation, as discussed on page 17 of Examiner's Answer.

The Examiner asserts that the motivation for modifying Novak with Bellis to include the limitation of "deactivating said tag with a deactivation device after receipt of said signal and while said product is in said substantially enclosed area" comes from one of ordinary skill in the art. Examiner's Answer, page 17. The Examiner though does not provide any reasons as to why one of ordinary skill in the art would

have been motivated to modify Novak to include the above-cited claim limitation. The Examiner must explain the reasons as to why one of ordinary skill in the art would have been motivated to modify Novak to include the above-cited claim limitation. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Instead, the Examiner is in essence relying on subjective belief and unknown authority which is insufficient to support a *prima facie* case of obviousness. *Id.* As a result, the Examiner has not provided a *prima facie* case of obviousness in rejecting claims 9-17 and 24-32. *Id.*

F. Other matters raised by the Examiner.

All other matters raised by the Examiner have been adequately addressed above and in Appellant's Second Appeal Brief and therefore will not be addressed herein for the sake of brevity.

II. CONCLUSION

For the reasons stated above and in Appellant's Second Appeal Brief, Appellant respectfully asserts that the rejections of claims 9-17 and 24-32 are in error. Appellant respectfully requests reversal of the rejections and allowance of claims 9-17 and 24-32.

Respectfully submitted,

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